IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: FRANKHUISEN Confirmation No. 9171

Application No.: 10/552,880

Filed: October 12, 2006

Group Art Unit: 1794

Examiner: WOOD, Ellen S.

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Customer No.: 30448

For: LABEL FOR WET APPLICATIONS

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

DATE: January 31, 2011

APPEAL BRIEF

Sir:

The Notice of Appeal was filed on July 21, 2010, along with a Pre-Appeal Brief Request for Review. A notice of the Panel Decision from Pre-Appeal Brief Review was mailed on September 2, 2010.

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I. STATEMENT OF THE REAL PARTY IN INTEREST

The real parties in interest in connection with the above-identified patent application are Collotype Services Pty Ltd, and Avery Dennison Materials Pty Ltd, the assignees of the present application.

II. RELATED APPEALS AND INTERFERENCES

There exist no related appeals or interferences in connection with the above-identified patent application.

III. STATUS OF CLAIMS

Claims 1-24 were pending in this application. Claims 1-24 stand rejected, with claims 1-11 and 15-24 rejected under 35 U.S.C. §102(b) as being anticipated, whereas claims 12-14 stand finally rejected under 35 U.S.C. §103(a) as being obvious. Claims 1-24 are being appealed.

IV. STATUS OF AMENDMENTS

No amendments were filed after issuance of the final office action dated March 3, 2010.

All previous amendments have been entered.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Aspects of the invention are directed to a laminated label. The independent claims recite alternative definitions and arrangements of the invention and are briefly reviewed below.

Claim 1 is directed to a label (2) of laminate construction, comprising an outer layer (3) for receiving printed indicia on an exposed surface thereof, and an under layer (5) attached to the outer layer. See specification at paragraph [0050] and Figures 2-3. The outer layer is made of a material that has an opacity, wherein the opacity of the outer layer material reduces after the outer layer (3) is exposed to moisture or liquid. See specification at paragraphs [0042]-[0044]. The under layer (5) is made of a different material that has an opacity, wherein the opacity of the under layer material, after exposure of the under layer to moisture or liquid, is configured not to be affected in the same manner as the opacity of the outer layer material. See specification at paragraphs [0058]-[0059].

Claim 16 is directed to a label (2) for a bottle (1), wherein the label is a laminate comprising an outermost layer (3) upon which there is printed indicia, and a lower or more inner layer (5) that is coupled between the outermost layer and the bottle (1). See specification at paragraph [0050] and Figures 2-3. The outermost layer (3) is made of a material that has an opacity that reduces after the outermost layer is exposed to moisture or liquid. See specification at paragraphs [0042]-[0044]. The lower or more inner layer (5) is made of another material that has another opacity that is substantially unaffected by exposure of the lower or more inner layer to moisture or liquid. See specification at paragraphs [0058]-[0059].

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The following grounds of rejection are requested to be reviewed on appeal.

(1) The Examiner's rejection of independent claims 1 and 16, and dependent claims 2, 4-11, 15 and 17-24 under 35 U.S.C. §102(b) as being anticipated by PCT Publication No. WO91/16025 to Samonides (hereafter "*Samonides*").

(3) The Examiner's rejection of independent claim 1, and dependent claims 2-6, 10, 15 and 23, under 35 U.S.C. §102(b) as being anticipated by Japanese Patent No. 10-180970 to Akio (hereafter "*Akio*").

(4) The Examiner's rejection of claims 12-14 under 35 U.S.C. §103(a) as being obvious over *Samonides*.

VII. ARGUMENTS

(1) Whether claims 1-11 and 15-24 are anticipated

MPEP §2131 states that:

> A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "When a claim covers several structures or compositions, either generically or as alternatives, the claim is deemed anticipated if any of the structures or compositions within the scope of the claim is known in the prior art." *Brown v. 3M*, 265 F.3d 1349, 1351, 60 USPQ2d 1375, 1376 (Fed. Cir. 2001) (claim to a system for setting a computer clock to an offset time to address the Year 2000 (Y2K) problem, applicable to records with year date data in "at least one of two-digit, three-digit, or four-digit" representations, was held anticipated by a system that offsets year dates in only two-digit formats). See also MPEP § 2131.02. "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

(A) Whether claims 1, 2, 4-11 and 15-24 are anticipated by *Samonides*

The Examiner rejected independent claims 1 and 16, and dependent claims 2, 4-11, 15 and 17-24 under 35 U.S.C. §102(b) as being anticipated by *Samonides*. The Examiner asserts that *Samonides* discloses a pre-printed label, which is asserted to consist of a carrier sheet (outer layer) which may be a white kraft paper (page 13, paragraph 1). Thus, the outer layer is asserted to have an opacity. A transparent face sheet (under layer) is asserted to be extruded onto the carrier sheet (page 13, paragraph 3), and that the face sheet may be transparent. It is asserted to

be inherent that when a paper layer is exposed to moisture or liquid the opacity would reduce, however when a polyolefin is exposed to moisture or liquid the opacity would retain.

This is in clear error in relation to the teaching of *Samonides*. As discussed in the amendment filed November 24, 2009, the carrier sheet 4 of *Samonides* discussed on page 13 relates to the first embodiment of label discussed in *Samonides* with respect to Figs. 1-6, and does not form part of the finished label. It "consists of the carrier or liner 6" (page 13, line 5) which has been "coated on its top surface with a suitable release coating 8" (page 8, lines 4-5). Page 8, lines 5-6 states that "[t]he composition of the liner 6 is not important." Notably, the composite carrier sheet 4 is removed from the adhesive backed label once the label is in place. Printing 28 is applied onto the adhesive layer 22, and a transparent face sheet 40 is extruded onto the printing indicia 28. Page 13, second paragraph states "the composite carrier sheet 4 may be readily peeled from the adhesive layer 22 without removing the adhesive from the transparent face sheet 40." The carrier merely acts to carry the label prior to application. Once the carrier sheet 4 is removed, the label can be applied to a surface using adhesive layer 22, leaving the face sheet 40 as the outer layer. The printing 28 is visible from the top, through the transparent face sheet 40. The Office Action asserts that the face sheet 40 would retain its opacity when exposed to moisture or liquid, and this is thus in direct contrast with the present claims, which require that the outer layer of the label has an opacity that reduces after the outer layer is exposed to moisture or liquid.

In the second embodiment of *Samonides*, shown in Figs. 7-12, a film 64 has printing 78 applied thereto, and a transparent adhesive layer 90 is extruded onto the top surface of the film

64 carrying the printing 78. A carrier sheet 96 having a release coating 98 is laminated onto the adhesive layer 90. In use, the carrier sheet 96 is removed, and the label applied to a surface such as a clear glass bottle. The printing 78 is visible through the adhesive, through the underside of the label.

In both embodiments of label disclosed in *Samonides*, therefore, the printing 28, 78 is sandwiched and protected between a sheet (the face sheet 40 or the film 64) and an adhesive layer 22, 90. Either the sheet or the adhesive layer is transparent, and the other layer may be opaque so that the protected printed indicia is visible through the transparent layer. *Samonides* teaches that the protection of the printing indicia with a transparent layer is important to preserve the finished appearance of the label. Furthermore, *Samonides* makes no reference to any change in the opacity of any of the labels upon exposure to moisture, which is required in the present claims.

Yet further, not only do the present claims require that the outer layer has an opacity that reduces after exposure to moisture, which is not taught by *Samonides*, present claim 16 also requires that the outer layer receives the printed indicia. This is also clearly not shown by *Samonides*, which teaches that the printed indicia should be on an inner, protected layer. The printed indicia on the labels defined in the present claims is not protected by a transparent outer layer, but is still readable even when the outer layer has been exposed to moisture, due to the opacity of the inner layer remaining unaffected by the moisture. The labels of the present claims retain the look and feel of a traditional paper label, but have readability advantages over the traditional labels.

For the foregoing reasons, it is clear that *Samonides* does not teach each and every element of the present claims. *Samonides* thus does not anticipate either of the independent claims 1 and 16, nor their dependent claims 2, 4-11, 15 and 17-24.

(B) Whether Claims 1, 2-6, 10, 15 and 23 are anticipated by *Akio*

The Examiner further rejected independent claim 1, and dependent claims 2-6, 10, 15 and 23, under 35 U.S.C. §102(b) as being anticipated by Japanese Patent No. 10-180970 to Akio (hereafter "*Akio*"). Applicant submits that the citation of *Akio* as a §102(b) reference is again a clear error, as *Akio* also does not anticipate independent claim 1, nor its dependent claims 2-6, 10, 15 and 23.

Akio relates to paper, which may be used in printers such as ink jet printers, and not a label as required in claim 1. While a piece of paper could be used to make a label, the two items are not the same. The Examiner states that "the broadest reasonable interpretation would define a label as a printed surface," however MPEP §2111 confirms that "[t]he broadest reasonable interpretation must also be consistent with the interpretation that those skilled in the art would reach." MPEP § 2111.01 confirms that the broadest reasonable interpretation must be made "in light of the specification" and that words in the claims must be given their plain meaning, unless the plain meaning is inconsistent with the specification. The Examiner has erred in not considering the plain meaning of the term "label," nor the meaning that is consistent with the understanding of those skilled in the art.

In dictionary.com, the definition of label when used as a noun is given as:

> 1. a slip of paper, cloth, or other material, marked or inscribed, for attachment to something to indicate its manufacturer, nature, ownership,

> destination, etc.
> 2. a short word or phrase descriptive of a person, group, intellectual movement, etc.
> 3. a word or phrase indicating that what follows belongs in a particular category or classification: *The following definition has the label "Archit."*
> 4. *Architecture* . a molding or dripstone over a door or window, esp. one that extends horizontally across the top of the opening and vertically downward for a certain distance at the sides.
> 5. a brand or trademark, esp. of a manufacturer of phonograph records, tape cassettes, etc.: *She records under a new label.*
> 6. the manufacturer using such a label: *a major label that has produced some of the best recordings of the year.*
> 7. *Heraldry* . a narrow horizontal strip with a number of downward extensions of rectangular or dovetail form, usually placed in chief as the cadency mark of an eldest son.
> 8. *Obsolete* . a strip or narrow piece of anything.

It is submitted that what is being claimed as a "label" falls within definition 1 above. That is, what is required to anticipate claim 1 is a slip of paper or the like which is to be affixed to something to indicate its manufacturer, nature, ownership, destination, etc. Thus, a piece of paper for use in printers is not a label because it does not indicate anything.

Second, *Akio* teaches that the outer paper layer is transparent. Paragraph 15 of *Akio* states:

> "In the laminated body of this invention, transparent pulp paper is used as the surface layer, and a body with a high degree of whiteness is used as the opaque support body layer. In this way, a laminated body that exhibits a high degree of whiteness, in accordance with the degree of whiteness of the support body layer can be obtained. The laminated body appears to have a high degree of whiteness because the surface layer is transparent pulp paper and the lower layer, the highly white support body, can be seen through it."

The surface pulp layer 1 thus does not have an opacity that "reduces after the outer layer is exposed to moisture or liquid" as required by the present claims, because it is transparent.

There is no teaching or suggestion in *Akio* regarding the Examiner's assertion that the surface pulp layer has an opacity nor that it reduces on exposure to moisture or liquid, because paper for office or home use is not intended to be used in an environment where moisture exposure is likely. *Akio* states that the paper can be used with "an office computer, a personal computer" for recording the output of, for example "a word processor, an electronic camera, a color copying machine, a facsimile, and a measuring device, and also is advantageously used as media for printing, such as offset printing and gravure printing." See paragraph 16 of *Akio*. As for the Examiner's assertion that it is not necessary to take this into account because it "is functional language of just the outer layer material and does not give rise to the function of the label," this is believed in error because the label is of laminate construction, and the function of one layer is clearly inextricably tied to the function of the entire label. The specification makes clear that this reduction in opacity is very much a function of the label.

For the foregoing reasons, it is clear that *Akio* does not teach each and every element of the present claims. *Akio* thus does not anticipate independent claim 1, nor its dependent claims 2-6, 10, 15 and 23.

(2) Whether claims 12-14 are rendered obvious by *Samonides*

MPEP §2142 states that:

> To reach a proper determination under 35 U.S.C. 103, the examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. In view of all factual information, the examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person. Knowledge of applicant's disclosure must be put aside in reaching

> this determination, yet kept in mind in order to determine the "differences," conduct the search and evaluate the "subject matter as a whole" of the invention. The tendency to resort to "hindsight" based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.
>
> ...
>
> The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 550 U.S. 198, 127, 82 USPQ2d 1385, 1396 (2007) noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Federal Circuit has stated that "rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also *KSR*, 550 U.S. at 398, 82 USPQ2d at 1396 (quoting Federal Circuit statement with approval).

The Examiner rejected claims 12-14 under 35 U.S.C. §103(a) as being obvious over *Samonides*. The Examiner stated that *Samonides* discloses the label of laminate construction as previously discussed, but that *Samonides* is silent as regards the level of opaqueness of the polypropylene plastic. As discussed in the section on anticipation, it is an error to state that *Samonides* teaches the label of laminate construction of claim 1, from which claims 12-14 depend. Further, the assertion that "[i]t would be obvious to one of ordinary skill in the art to use an appropriate level of opaqueness of the white face sheet when applying the label to a glass bottle, because the white face sheet and level of opaqueness provides the printed indicia to appear when the label is wet" is erroneous.

First, claim 12 does not require "an appropriate level of opaqueness" but instead requires a specific opacity of the plastic film under layer that is greater than 0.54. Given that claim 1

requires that the outer layer has an opacity that reduces after exposure to moisture or liquid, it is not obvious to a person of ordinary skill in the art that for the purposes of making the "printed indicia to appear" that the under layer should have a specific opacity. In particular, if the outer layer has an opacity and receives the printed indicia, the appearance of the printed indicia in dry conditions is much more dependent on the opacity of the outer layer than on the opacity of the under layer. Thus, a typical situation would be to have an outer layer receiving printed indicia having an opacity of 1.0, which is the opacity of a perfectly opaque layer. As noted above, *Samonides* teaches that its outer layer is transparent. For showing printed indicia on the under layer of *Samonides* underneath a transparent outer layer, a person of ordinary skill in the art would expect that the opacity of the under layer should be 1.0. Therefore, providing an under layer with a specific opacity of at least 0.54 is not obvious with reference to *Samonides* because a person of ordinary skill in the art would expect such a low opacity to deleteriously affect the readability of the printed indicia.

No arguments were made by the Examiner as to the reasons for the rejections to claims 13 and 14. Thus, no prima facie case for obviousness of these claims has been made.

For the foregoing reasons, it is clear that the rejections of claims 12-14 based on obviousness over *Samonides* are based on impermissible hindsight, and do not set out clear articulations as to why these claims would have been obvious to a person of ordinary skill in the art at the time the invention was made.

VIII. CLAIMS APPENDIX

1. A label of laminate construction, comprising:

an outer layer for receiving printed indicia on an exposed surface thereof; and

an under layer attached to the outer layer, wherein:

the outer layer is made of a material that has an opacity, wherein the opacity of the outer layer material reduces after the outer layer is exposed to moisture or liquid, and

the under layer is made of a different material that has an opacity, wherein the opacity of the under layer material, after exposure of the under layer to moisture or liquid, is configured not to be affected in the same manner as the opacity of the outer layer material.

2. The label as in claim 1, wherein the outer layer is adhered to the under layer, the under layer being a film of plastics material.

3. The label as in claim 1, wherein the under layer is a plastics material which is white.

4. The label as in claim 1, wherein the outer layer is secured to the under layer by a permanent adhesive.

5. The label as in claim 1, wherein the under layer is adapted to be a stable laminate base.

6. The label as in claim 5, wherein the under layer provides an innermost surface adapted to facilitate adhesion to an outer surface of a container.

7. The label as in claim 1, wherein the label is attached to the outer surface of a container by self-adhesive.

8. The label as in claim 2, wherein the label is attached to the outer surface of a container by a glue, which is applied to the label when the glue is wet and which is allowed to dry when in situ on the container.

9. The label as in claim 7, wherein the container is a glass bottle.

10. The label in accordance with claim 1, wherein the under layer is a plastics material comprising at least one of the group consisting of biaxial polyethylene, non-orientated polypropylene and PET.

11. The label in accordance with claim 1, wherein the under layer is a biaxial oriented polypropylene plastic film.

12. The label as in claim 11, where the biaxial oriented polypropylene plastic film has

opaqueness greater than 0.54 as measured by a Tobias densitometer.

13. The label as in claim 11, wherein the biaxial oriented polypropylene plastic film under layer is a five layer extruded film.

14. The label as in claim 13, wherein the biaxial oriented polypropylene plastic film under layer has a cavitated inner core.

15. The label as claim 3, wherein the outer layer is joined to the under layer by being applied directly onto a sheet of extruded plastics material.

16. A label for a bottle wherein the label is a laminate, comprising:

an outermost layer upon which there is printed indicia; and

a lower or more inner layer that is coupled between the outermost layer and the bottle, wherein:

the outermost layer is made of a material that has an opacity that reduces after the outermost layer is exposed to moisture or liquid; and

the lower or more inner layer is made of another material that has another opacity that is substantially unaffected by exposure of the lower or more inner layer to moisture or liquid.

17. The label as in claim 16, wherein the lower or inner layer is an innermost layer.

18. The label as in claim 16, in which the lower or inner layer is a plastics material.

19. The label as in claim 16, wherein the laminate has each layer of the laminate joined to adjacent layers by water insoluble means or materials.

20. The label as in claim 19, wherein the water insoluble means are a fusion of plastics material with a respective adjacent layer.

21. The label as in claim 16, wherein the label is secured to an outermost surface of the bottle,

wherein the innermost layer of the laminate is adhered directly onto an outer surface of the bottle with substantially water insoluble means or material, and

wherein the outermost layer is positioned to be outermost with respect to the bottle so as to display the printed indicia thereon.

22. The label as in claim 8, wherein the container is a glass bottle.

23. The label as in claim 2, wherein the outermost layer is paper.

24. The label as in claim 18, wherein the outer layer is paper.

IX. EVIDENCE APPENDIX

None.

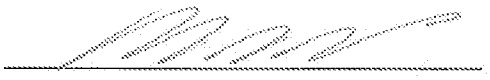
X. RELATED PROCEEDING APPENDIX

None.

CONCLUSION

For at least the reasons given above, claims 1-24 define patentable subject matter and are thus allowable. The Applicant requests withdrawal of the rejections and allowance of the claims.

Respectfully submitted,



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